

## **REMARKS AND ARGUMENTS**

### *STATUS OF THE APPLICATION*

The application was filed on March 29, 2001, claiming the benefit of a prior provisional application filed on March 29, 2000. A second Office Action was mailed on February 23, 2003 that appears to incorrectly state on the Office Action Summary sheet that the action is responsive to Applicant's communication filed on "29 March 2000" when it is believed to in fact be responsive to a communication filed on July 29, 2004.

Claims 1-6, 8-10 and 12-19 are presently pending in the application, each standing rejected in view of prior art cited in the Office Action mailed February 23, 2005. Applicant respectfully traverses the substantive bases for rejection of the claims.

### *REMARKS*

The claims have been amended to clarify the scope of the invention, to distinguish the invention over the prior art and to place the application, as a whole, into a *prima facie* condition for allowance. Care has been taken to avoid the introduction of any new subject matter into the application as a result of the foregoing amendments.

### *Claim Rejections Under 35 U.S.C. 103*

Claims 1, 2, 5-8, 12, and 14 - 18 stand rejected under 35 U.S.C. 103(a), as being purportedly unpatentable over *Beukema et al.*, U.S. Patent No. 6,128,510 in view of newly cited referece, *Peterson et al.*, U.S. Patent No. 6,728,546. Applicant respectfully traverses the Office Action's substantive bases for rejection of the claims.

*Beukema et al.* discloses a cordless telephone system including a base unit connected to a telephone line, and remote units capable of communicating with the base unit via a wireless communication link. The remote units can transmit and receive audio signals for implementing conventional telephony applications, including communication of voice signals as well as the output of a phone line computer data/fax modem.

*Beukema et al.* is directed specifically to the operation of the base unit and remote units to alter the characteristics of the wireless communication protocol to optimize the protocol for communication of voice signals or data/fax modem signals, depending upon the type of call being conducted. For example, the base and remote units (1) alter the frequency deviation used to frequency-modulate the baseband signal based upon the signal type (*i.e.* voice or modem) (*see, e.g., Beukema et al.*, 8:11-20); (2) alter the bandwidth of the receiver predetection filter to optimize filtering for the active signal type (*i.e.* voice or modem) (*see, e.g., Beukema et al.*, 5:41-47, 8:11-20); and (3) switch a compander into the signal path for voice communications while removing the compander from the signal path while a data/fax modem signal is being communicated (*see, e.g., Beukema et al.*, 7:64-8:4). The Examiner acknowledges that *Beukema et al.* fails to teach a third wireless transceiver that communicates data other than that required for voice telephony with the first transceiver via the cordless telephone communications protocol.

*Peterson et al.* entitled "Computer Peripheral Base Station For A Cordless Telephone" discloses a conventional personal computer that executes the functions of a cordless telephone base unit when a cordless telephone device or card 22 is installed into a connector slot on the system motherboard. A cordless telephone handset 30 wirelessly communicates with card 22 and sound card 26 which includes a fax/modem card to communicate with a public switched telephone network via line jack 33. In this embodiment, the computer display and keyboard are used to dial an outgoing call and otherwise control use of the telecommunication system. Alternatively, a telephone base unit may be included in the personal computer to establish a conventional cordless telephone link with a handset. However, in such case only the PSTN network is used to make or receive calls as the base unit is not connected to any other computer components. *Peterson et al.* further discloses the use of display device, such as a photo album or electronic book, which is in wireless communication with the personal computer to display to a user information in the form of photographs or pages of a book. The disclosed embodiments contemplate the ability to transfer photographic images and pages of an electronic book from the personal computer to an electronic photo album or book via an RF link where such images and pages were previously stored in memory within the personal computer. The Examiner argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of *Peterson et al.* into the system of *Beukema et al.*. For the reasons set forth below, Applicant respectfully disagrees.

Applicant has amended Claim 1 to incorporate the limitations of Claim 7 and has cancelled Claim 7. Applicant submits that Claim 1 as amended clearly requires that the cordless telephone handset and the digital electronic device each communicate with the first transceiver via a common communications protocol for both voice and data communications and that the digital electronic device also be capable of communicating non-voice data with a second communications network via a second separate communications port. Applicant further notes that the Examiner has withdrawn the prior basis for the rejection of Claim 7.

*Beukema et al.* in view of *Peterson et al.*, does not render Claim 1 obvious because *Peterson et al.* does not teach for providing any mechanism for an external device to communicate with a communication network. The communication between the personal computer of *Peterson et al.* and an external device in the form of an electronic album or book (other than a cordless phone) relates solely to the transfer of digital photographic or images or text pages where such content is stored within and retrieved solely from the computer's on-board memory.

*Peterson et al.* fails to disclose, teach or suggest, the photo album or electronic book communicating with an external communication network (such as the PSTN or Internet) via the personal computer. In short, the personal computer of *Peterson et al.* while serving to permit a cordless handset to conduct a telephone call via either a PSTN (circuit switched telephone network) or Internet, does not serve as a "gateway" to permit either album or book device to communicate with any external network.

Moreover, there is no disclosure in *Peterson et al.* of a second communications port as claimed in amended Claim 1. Applicant moreover respectfully disagrees with the Examiner's assertions set forth in the Office Action in regard to Claim 7 as it relates to a second communications port. In addition, the second communications port referred to by the Examiner has being disclosed in *Peterson et al.* is in fact a port contained within the external digital device and not the personal computer. Moreover, to the extent that one attempts to identify a second communications port, such a port does not serve to permit an external digital device to communicate with anything other than the personal computer itself, yet alone with a second separate communications network.

For at least these reasons, Claim 1 as amended is not rendered obvious by *Beukema et al.* in view of *Peterson et al.*.

Claims 2, 5, 6, 8 12, and 14 -18 are dependent claims, each of which ultimately depends from Claim 1. Therefore, inasmuch as Claim 1 is not anticipated by *Beukema et al.* in view of *Peterson et al.*, Claims 2, 5, 6, 8, 12 and 14 - 18 are not obvious.

Claims 3 and 4 stand rejected under 35 U.S.C. 103(a) are being purportedly unpatentable over *Beukema et al.* in view of *Peterson et al.*, U.S. Patent No. 6,728,546 further in view of *Huang*, U.S. Patent No. 6,675,027. Applicant respectfully traverses the Examiner's substantive bases for rejection of the claims.

*Huang* discloses a personal mobile computing device having a particular configuration of one or more microphones in order to improve the audio quality with

which speech is detected by the microphone(s). (*Huang*, 2:19-30.) The mobile device can be a cellular or digital wireless telephone, a PDA or a portable handheld computer. (*Huang*, 2:31-34, 3:9-14.) The mobile device can be adapted for communication with a "wireless transport", which is described as "a paging network, cellular digital packet data (CDPD), FM-sideband, or other suitable wireless communications." (*Huang*, 3:3-5.) *Huang* provides no detailed disclosure of the structure or operation of any wireless base unit.

Claim 3 depends from amended Claim 1 and further requires that the digital electronic device is a personal digital assistant. *Beukema et al.* in view of *Peterson et al.* does not disclose the use of a common communication protocol by both a cordless telephone and a separate digital electronic device, to convey data other than that required for conventional telephony, to and from a cordless base unit, nor does it disclose the use of first and second communications ports as claimed, nor does it disclose providing any mechanism for an external device to communicate non-voice data with a separate communications network. Likewise, *Huang* also does not disclose the use of a common communication protocol by both a cordless telephone and a separate digital electronic device to convey data other than that required for conventional telephony, to and from a cordless base unit. Indeed, Applicant submits that *Huang* does not address communication with a cordless telephone system at all, but rather contemplates communications using wide-area systems such as cellular or

paging systems which operate independently of the base unit and its connection to any particular communication network.

Claim 3 is also not obvious in view of *Beukema et al.*, *Peterson et al.* and *Huang* because none of the references disclose the use of a cordless telephone base station as the hub of a wireless network for both voice (i.e. audio) and non-voice communications. The invention of Applicant's Claim 3 provides increased flexibility and functionality by providing both voice (i.e. audio) communications between a first and a second transceiver, and non-voice digital data communications between the first and the third transceivers – all using a common cordless telephone communications protocol.

Claim 3 is also not obvious in view of *Beukema et al.*, *Peterson et al.* and *Huang* because there is no motivation to combine the teachings of *Huang* with *Beukema et al.* and *Peterson et al.* In order for a claim to be obvious in view of multiple prior art references, there must be a motivation to combine the references that is found in the prior art – not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959).

In this case, the Office Action contends that, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of *Huang* into the system of *Beukema et al.* and *Peterson et al.* so that the personal digital

assistant can be controlled by the cordless base station.” However, there is no motivation in the cited prior art to interface a personal digital assistant with a cordless telephone base station – particularly for purposes of implementing non-audio data communications. *Huang* is not directed to the cordless telephone environment of *Buekema et al.* Furthermore, *Buekema et al.* is directed towards the use of a data/fax modem over a cordless telephone system. However, the PDA of *Huang* does not feature a data/fax modem, nor is a data/fax modem a common feature in a PDA.

Thus, there exists no motivation to combine the teachings of *Beukema et al.* with *Huang* to achieve Applicant’s invention of Claim 3. Furthermore, even if such motivation existed, the combined references still fail to disclose or suggest each and every element of Claim 3.

Claim 4 depends from Claim 3, and further requires that the personal digital assistant is comprised of an audio input and an audio output, and voice data is routed between the personal digital assistant audio input and output and the base unit telephone line interface, via the third transceiver and the first transceiver, to conduct voice telephony. Inasmuch as Claim 4 depends from non obvious Claim 3, Claim 4 is also not obvious.

In view of the foregoing, Applicant respectfully submits that the Examiner’s bases for rejection of Claims 3 and 4 under 35 U.S.C. 103, should be deemed overcome, and reconsideration and withdrawal of same are respectfully requested.



Claims 9 and 10 stand rejected under 35 U.S.C. 103(a) as being purportedly obvious over *Beukema et al.* in view of *Peterson et al.* further in view of *Sumner*, U.S. Patent No. 6,091,947. Applicant respectfully traverses the Office Action's substantive bases for rejection of the claims.

*Sumner* discloses a mobile telephone system that, upon receipt of a call, evaluates the available transmission rate between the mobile phone base station and the mobile phone. When the link conditions are such that a call cannot be conducted normally, the caller is diverted to a voicemail account associated with the mobile telephone. The system may then be able to forward a stored message to the mobile telephone, despite link conditions being inadequate for conducting a normal telephone conversation.

Claim 1 as amended requires that the base unit comprises a second communications port through which the microprocessor communicates with a digital communications network, whereby digital data communications can occur between the digital communications network and the digital electronic device.

The Office Action concedes that the applied references fail to teach the limitations recited in claim 9, namely the second communications port disposed on an expansion module that can be alternatively installed or removed from the base unit, but contends that *Sumner* discloses the claimed communications port to a second network, citing Figure 1 reference 104, and column 3 lines 24-46.

Applicant submits that the foregoing rejection is an inadvertent carry over from the prior Office Action and indeed does not relate to the subject matter of Claim 9. Indeed, the Examiner concedes that the applied references fail to teach the communication port disposed on an expansion module that can be alternatively installed into or removed from the base unit.

The Examiner goes on to take "Official Notice" that the claim limitation is well known in the art to provide a flexible communication network. While Applicant recognizes that expansion devices are certainly known in the art, Applicant respectfully submits that the a second communication port disposed in an expansion module within the context of the present invention and as claimed by Claim 9, is not at all common knowledge in the art. Indeed, the cited prior art itself (namely, *Beukema et al.*) illustrates that such modems are conventionally connected to a device such as a computer, rather than provided in an expansion module for a cordless telephone base unit as required by Claim 9. Thus, Applicant hereby traverses the Official Notice upon which the Office Action relies, and respectfully requests that the Examiner either reconsider and rescind the basis for rejection of Claim 9, or provide documentary evidence supporting the Official Notice in the next Office Action.

Lastly, Applicant submits that Claim 9 has been amended to be dependent upon Claim 1. To the extent that Claim 1 is nonobvious, Claims 9 is likewise inherently nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 10 is dependent upon Claim 1, and further requires that the base unit is comprised of an analog data modem capable of communicating data from the base unit microprocessor to a second digital communications network through the telephone line interface.

The Office Action concedes that the combination of *Beukema et al.* and *Peterson et al.* fails to teach the claimed base unit with analog data modem. The Examiner submits that *Sumner* teaches a communication port which is connected to the base by the modem citing Figure 1 reference 104, and column 3 lines 24-46 and that accordingly it would have been obvious of one of ordinary skill in the art to provide the teaching of *Sumner* into the system of *Buekema et al.* and *Peterson et al.* to provide users with different services -- and yet, the Examiner concedes that the combination of all three references still fails to teach an analog or digital modem.

The Examiner goes on to again take "Official Notice" that an analog modem is purportedly "known in the art for communicating data from the base unit processor to a second digital communication network." While Applicant recognizes that analog data modems are certainly known in the art, Applicant respectfully submits that the cordless telephone base unit which includes an analog data modem, as claimed by Claim 10, is not at all common knowledge in the art. Indeed, the cited prior art itself (namely, *Beukema et al.*) illustrates that such modems are conventionally connected to a device such as a computer, rather than integrated with a cordless telephone base unit as required by Claim 10. Thus, Applicant hereby traverses the Official Notice upon which

the Office Action relies, and respectfully asserts that the Examiner has not provided documentary evidence supporting the Official Notice.

Moreover, Applicant submits that Claim 10 is dependent upon Claim 1 which is non-obvious and that therefore, Claim 10 is necessarily likewise non-obvious

Claim 13 stands rejected under 35 U.S.C. 103(a) as being purportedly obvious over *Beukema et al.* in view of *Peterson et al.* further in view of *Kim et al.*, U.S. Patent No. 5,420,577. Claim 13 is dependent upon Claims 12 and 1, both of which are non-obvious. Therefore, Claim 13 is necessarily likewise non-obvious.

Claim 19 stands rejected under 35 U.S.C. 103(a) as being purportedly obvious over *Beukema et al.* in view of *Peterson et al.* and in further view of *Reeds*, U.S. Patent No. 5,172,414. Claim 19 is dependent upon Claim 1, and the base unit is further comprised of a first encryption key for encrypting data transmitted to the digital electronic device, and a second encryption key for encrypting data transmitted to the second communications network. Inasmuch as Claim 19 is dependent upon nonobvious Claim 1, Claim 19 is likewise nonobvious.

In view of the foregoing, Applicant respectfully submits that the Office Action's bases for rejection of Claims 1-6, 8-10 and 12-19 under 35 U.S.C. 103, should be deemed overcome, and reconsideration and withdrawal of same are respectfully requested.

#### *Conclusion*

In conclusion, Applicant respectfully submits that the application as a whole, including all of claims 1-6, 8-10 and 12-19, is now in *prima facie* condition for

allowance, and reconsideration and allowance of the application are respectfully solicited.

Should anything further be required, a telephone call to the undersigned at (312) 456-8400 is respectfully solicited.

Respectfully submitted,

Dated: 7/25/05

  
Howard E. Silverman

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I hereby certify that this Amendment and Communication is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Dated: 7/25/05

  
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